

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/501,747

Applicant(s)

MANNHART, JOCHEN DIETER

Examiner

KALLAMBELLA
VIJAYAKUMAR

Art Unit

1793

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 06 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
b) ☐ They raise the issue of new matter (see NOTE below);
c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 60.
Claim(s) objected to: 45.
Claim(s) rejected: 41, 42, 46-48 and 50-59.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: PTO-892 of 04/18/2008.

/Stanley Silverman/
Supervisory Patent Examiner, Art Unit 1793

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed 04/06/2009 have been fully considered and they are not persuasive for the following reasons:

In response to the argument that "Applicant disagrees with this interpretation of Feldman," Feldman has been specifically used to show the obvious presence/formation of grain structure in the direction of rolling i.e. length of the tape i.e. direction of current flow in the process/tape of Truchan, and not the grooves as argued (Res, Pg-2, Para-4 and Pg-3) (See office action: Pg-3, Para-3). The obvious formation and the presence of grooves was argued based on prior art process in comparison with the processes taught by the applicants, and the grain structure of the prior art tape. The presence of grooves along the grain edges in the biaxially textured metallic substrates is well known in the art, wherein the prior art process of making the tape is similar to that by Truchan (US 6,455,166), which is the primary reference in the last office action (See Thieme et al; PTOL-892, 6/29/07; US 6,458,223: Cl-3, Ln 18-20; Cl-4, Ln 47-63; Cl-8, Ln 22-38; Cl-12, Ln 3-5; Also See Robbins et al; US 6,500,568; Cl-5, Ln 4-6 and 14-17). In response to the "polishing step" in creating desired grooves (Res, Pg-2, Para-5), that is not the limitation of the instant independent claim-41; and although "That claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims." <See MPEP 2106 [R-6]-IIC>.

In response to the argument that "In contrast, the claimed invention recites a specific claim step of forming grooves on the surface of the substrate or buffer layer in the direction of the current flow. Feldman does not disclose or suggest any such treatment", (Res, Pg-3, Para-3; Last 4-Lines), the examiner presented the argument for the obvious presence/formation of the grooves along the edges of the grains which is known in the art, and applicants fail to overcome this prima facie obviousness and fail to patentably distinguish their process over the prior art. The combined prior art does not specifically teach a separate step of forming grooves, and the examiner presents the obvious formation of grooves in the prior art process, and Omission of an Element/process-step and Its Function Is Obvious If the Function of the Element/process step Is Not Desired Ex parte Wu , 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) <MPEP 2144.04>.

Further applicants do not address the rejection of product in claim-50 and patentably distinguish their product by process over prior art product.

It is suggested that applicant's attorney call the examiner to discuss the patentability issues.

/KMV/
April 18, 2009.